

resistance based sensor is used to indirectly sense a process variable." The Office Action asserted,

"It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply Eryurek I diagnostics for resistance based field device to diagnostic circuitry coupling to a fieldbus process communication loop, and substitute the direct coupling by an indirect coupling as taught by Eryurek I in the Burns system in order to provide a workable and robust alternative for diagnosing a fieldbus process communication loop."

Applicants respectfully traverse this rejection in view of the following.

Independent claim 28 recites: "a method of providing diagnostics on a fieldbus process communication loop, the method comprising: indirectly coupling diagnostic circuitry to the fieldbus process communication loop; measuring a parameter of the loop; and analyzing the parameter to provide a diagnostic output."

Applicants' specification on page 6, lines 18-22 provides "indirect coupling" is intended to mean any diagnostic circuit that measures a parameter of a circuit of interest without electrically coupling to the circuit of interest. Respectfully, it is asserted that neither the Burns et al. reference nor the Eryurek I reference teach or suggest this indirect coupling as defined in applicants' specification. Additionally, it is applicants' own disclosure that has taught the benefits of indirect coupling and to use the teaching of such benefits as a motivation for combining Burns et al. with the Eryurek I reference is to apply impermissible hindsight. Accordingly, applicants respectfully submit that the standard used for combining references in this case does not follow the current standard as set forth in the Federal Circuit decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002). A copy of this decision is provided for convenience.

The court of Lee held that a factual inquiry on whether to combine reference must be based on objective evidence of record, which is being reinforced in a number of decisions. In re Lee at 1443, citing McGinley v. Franklin Sports, Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001) and Brown & Williamson Tobacco Corp. v. Phillip Morris Inc., 56 USPQ 2d 1456, 1459 (Fed. Cir. 2000).

Other notable quotes on In re Lee include "a showing of a suggestion, teaching or motivation to combine the prior art references is an 'essential component of an obviousness holding'", quoting C.R. Bar Inc. v. M3 Systems, Inc., 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) "there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the application", In re Fine, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) and "'teachings of references can be combined only if there is some suggestion or incentive to do so.'" [emphasis in the original], quoting ACS Hops. Sys., Inc. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984). Id.

As set forth above, applicants respectfully submit that the motivation used by the Office Action to combine the teachings of Burns et al. and Eryurek I does not comport with the current standard as set forth by the Federal Circuit. Accordingly, applicants respectfully submit that a *prima facie* case of obviousness has not been set forth under 35 U.S.C. § 103. However, even if these two references could be combined, the combined teaching would fail to reach the subject matter of independent claim 28 because that claim requires indirect coupling which, as defined by applicants' specification, is neither taught nor suggested in either the Burns et al. reference nor the Eryurek reference. Accordingly, applicants respectfully submit that independent claim 28 is allowable over the art of record. Further, applicants respectfully submit that dependent claims 29-33 are allowable as well by virtue of their dependency either directly or indirectly, therefrom.

In conclusion, applicants respectfully submit that the entire application is now in condition for allowance. Reconsideration and favorable action are respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

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